

Amendments to the Drawings:

In FIG. 2 attach label "52" to the oversized aperture in the body mounting plate 5 that receives bolt 20 per the change shown in red on the Annotated Marked up Drawing in Appendix 1.

REMARKS

The Examiner objected to the following informalities: at page 4, line 8 "aperture 21" and at page 4, line 16 "aperture 21" should have been "aperture 24" according to the figures.

The Examiner has rejected claim 2 under 35 U.S.C. §112, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The Examiner has rejected claims 1-13 under 35 U.S.C. §103 as being unpatentable over Vernier (5,624,150) in view of Bisbing (5,150,500).

1. Aperture 24 was inadvertently identified as "aperture 21" on lines 8 and 16 of page 4. The amendment to the specification made above correctly conforms the specification to FIG. 2.

2. The Examiner states in his rejection of claim 2 under 35 U.S.C. §112 that it is unclear what "an oversized aperture in said body mounting plate" refers to in original claim 2 and that there is insufficient information referring to the aperture for bolt 20. The phrase "through an oversized aperture in the body mounting plate" is taken from the original claim 2 and inserted into the body of the specification by the above amendment to comply with second paragraph 35 U.S.C. 112. This oversized aperture for receiving bolt 20 is present in FIG. 2 but unlabeled. FIG. 2 is amended hereby to label this aperture "52" and this label is inserted into the text at page 4 line 4 following "aperture".

Claim 1 lists "means for adjustably attaching said hinge plate to said body-mounting plate". Claim 2 specifies a means, i.e., "a bolt that is longitudinally retained to extend from said hinge plate and through an oversized aperture in said body mounting plate". The specification (page 3 line 30 to page 4 line 6) details various "means for adjustably attaching said hinge plate", including the use of bolt 20. "FIG. 2 shows an exploded view of the adjustable hinge assembly 2 where the body mounting plate 5 is shown detached from the hinge plate 6. A small bolt 20 is shown

that may be used to initially loosely attach the body mounting plate 5 to the hinge plate 6. The purpose of this bolt 20 is merely to hold the body mounting plate 5 to the hinge plate 6 during the process of attaching the door 1 to the body 3. It loosely holds the two plates together through an oversized aperture 52 in the body mounting plate, allowing some freedom of movement between the convex surface 15 of the body mounting plate 5 and the concave surface 14 of the hinge plate 6. A wire or other flexible attachment device also could be used to fulfill this function." The oversized aperture in the mounting plate 5 enables a flexible attachment of the mounting plate 5 to the hinge plate 6 using the bolt 20.

3. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venier (5,624,150) in view of Bisbing (5,150,500). In rebuttal, the Applicant contends that no *prima facie* case for obviousness has been made out by the Examiner. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." (MPEP §2143)

There must be a basis in the prior art for combining or modifying the references. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F. 2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner has not identified any part of either the Venier or Bisbing references that contain any suggestion or motivation to combine the references to obtain the present invention. The Examiner merely states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify ..." This is not a sufficient basis to meet the first basic criteria needed to establish a *prima facie* case for obviousness. "The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) as quoted in the MPEP 2143.01. Conclusory statements standing alone are not evidence; particular findings

as to motivation, suggestion, or teaching are required. *In re Kotzab*, 217 F.3d. 1365 at 1370 (Fed. Cir. 2000).

The Examiner states that Vernier: "'150 discloses a vehicle door having two hinges (see fig.3). Each hinge has a door mounting plate (10), a pin (7), a hinge plate (5), and attaching means (31, 21, P5A, P4A). '150 does not show a body-mounting plate." In '150, the conventional hinge of is labeled (5) in the specification and drawings, not the hinge plate. The hinge (5) consists of a door mounting plate (10), a pin (7), and a hinge plate (20). The hinge (5) of '150 differs from the present invention in that the hinge plate (20) of '150 is flat and directly engages the "outer surface (P3) of outer hinge pillar (P2)" (column 5, lines 14-15). The '150 hinge plate does not have a spherical curved concave surface and, of course, it is not attached to a body-mounting plate prior to being attached to the vehicle pillar. Furthermore, the '150 reference only teaches a hinge fastening structure and method of attaching hardware to an automobile box-section pillar joint with the object of providing improved rigidity. It does not anywhere teach or suggest that its structure could be modified to become an adjustable hinge assembly.

The Examiner further states that Bisbing: "'500 teaches a hinge having a hinge plate (28) with a concave surface (50), a body plate with a convex surface (32), and adjustable attaching means (42, 52, 44) to enable the hinge to be adjusted easily and accurately to prevent misalignment of a door. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the hinge of '150 with a concave hinge plate and a convex body-mounting plate as taught by '500 so that the hinge can be adjusted to prevent misalignment of a door." However, the adjustable lift-off hinge in '500 is completely different in function, purpose and design from the conventional hinge in '150. The adjustable lift-off hinge assembly of '500 comprises a support member (12) about which the door would pivot and which is fixedly mounted to the vehicle frame (22). This would have to be equivalent to the '150 door mounting plate (10) and to the similar door mounting plate (7) of the present invention; neither were designed to be a lift-off type of assembly. The '500 patent then uses a knuckle assembly (24) attached to the vehicle body. The knuckle assembly (24) is comprised of a longitudinal adjustable knuckle member (28), called a hinge plate by the Examiner, and means for pivotally coupling a fixed base member (26) to the adjustable knuckle member (28) (column

3, lines 33-37). The fixed base member (26) has a planar surface (30) for mounting the fixed base member (26) to the door (20), and a cylindrically convex outer surface (32) along its longitudinal axis (column 3, lines 39-43). This permits adjustment about the longitudinal axis only when the fixed base member (26) is pivotally coupled to the adjustable knuckle member (28).

There is no equivalent structure in the '150 reference. Nor is there an equivalent structure in the present invention because it has a body mounting plate (5) with a spherically convex outer surface (15) which when pivotally coupled to the spherically concave base portion (14) of the hinge plate (6) permits adjustment about two axes of rotation. Note that the hinge plate (6) and the body mounting plate (5) are mounted on the vehicle body, not on the door as in the '500 reference. The purpose is to be able to adjust the door along two axes when it is being mounted on the vehicle frame, not to provide a lift-off hinge than can be adjusted in the longitudinal axes only. Furthermore, there is no suggestion, teaching, or other indication in '150 that it could be combined with '500 to produce the present invention. In fact, if the two were to be combined, it would not produce a door mount adjustable in two axes.

A prima facie case for obviousness has not been made. First, there is no suggestion, teaching, or any other indication that '150 could be modified or combined with '500. Secondly, there is no showing of a reasonable expectation of success. In fact, Venier combined with Bisbing would not produce the claimed invention. Thirdly, the references when combined do not teach or suggest all the claim limitations, e.g., the '500 reference is adjustable only along the longitudinal axis while the present invention is adjustable in two axes.

As to claim 3, the Examiner states that it would have been obvious to form the attaching apertures in the body-mounting plate (26) of '500 with oversized apertures to provide positioning adjustment of the plate. In '500 the body-mounting plate (26) is fixedly mounted to the door (20) with two bolts (31, 31') and subsequently the longitudinally adjustable knuckle member (28) is attached by a bolt (42) to a special cylindrically curved threaded nut (44) through an oversized aperture (40) in the body-mounting plate (26). The present invention uses just two bolts (32, 32) to mount and lock into position the two-axis adjustable hinge assembly (2) and the body mounting plate (5) to the vehicle frame in a single more efficient operation.

No other art is cited in the Office Action. Based on the foregoing comments, the above-identified application is believed to be in condition for allowance, and such allowance is courteously solicited. If any further amendment is necessary to advance prosecution and place this case in allowable condition, the Examiner is courteously requested to contact the undersigned by fax or telephone at the number listed below.

Please charge any cost incurred in the filing of this Amendment, along with any other costs, to Deposit Account 06-1510. If there are insufficient funds in this account, please charge the fees to Deposit Account No.06-1505.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul K. Godwin", written over a horizontal line.

Paul Godwin
Attorney or Agent of Record
Registration No. 27725

Borda, Lorenz & Geggie PLLC
Crystal Glen Office Centre
39555 Orchard Hill Place, Suite 370
Novi, Michigan, 48375-5394

Telephone: 810-844-0032
Customer No. 022844
Date: 8/30/2005